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STATEMENT

OF THE

COMMISSIONER OF PATENTS

ON

H. R. 20036

DECEMBER 16, 1914

HOUSE OF REPRESENTATIVES

SIXTY-THIRD CONGRESS

SECOND SESSION

COMMITTEE ON PATENTS.

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TEMPORARY EXTENSION OF TIME FOR FILING APPLICATION FOR PATENT.

COMMITTEE ON PATENTS,
HOUSE OF REPRESENTATIVES,
Wednesday, December 16, 1914.

The committee met at 11 o'clock a. m.

Present: Representatives Oldfield (chairman), Morrison, Callaway, Hill, Moss, Kreider, and Lindquist.

Present also: Hon. Thomas Ewing, Commissioner of Patents.

The committee thereupon proceeded to the consideration of the bill H. R. 19642, which is as follows:

A BILL To extend temporarily the time of filing applications for letters patent and registration in the Patent Office.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That whenever an applicant for letters patent or for the registration of a trade-mark or label is unable on account of the existing state of war to file an application or pay any official fee within the period now limited by law, then the Commissioner of Patents will, upon petition, accept such application or fee within an additional period of nine months. This act shall be deemed effective from the first day of August, nineteen hundred and fourteen.

SEC. 2. That all letters patent and registrations to which the preceding section applies shall have the same force and effect as if the applications and fees had been filed in accordance with the existing laws.

SEC. 3. That section one of this act shall remain in force until the first day of January, nineteen hundred and seventeen.

STATEMENT OF HON. THOMAS EWING, COMMISSIONER OF PATENTS.

The CHAIRMAN. What does the bill provide, Mr. Commissioner?

Commissioner EWING. The bill provides for giving the applicants—mainly foreign applicants—an extension of nine months' time within which to file applications and pay fees for any purposes. Under the present act, section 4887, an applicant who has a patent abroad, or who has filed application for a patent abroad, may file here within one year of the date of the filing abroad and his patent will not be affected by his foreign patent. If, however, he files a day after the year and has already obtained a foreign patent, or obtains one before he obtains his patent here, his patent here is void. Then, in the course of the prosecution of applications in the office, there are fees that have to be paid after certain periods.

The purpose of this bill is to give an extension of nine months generally for applications of patents, trade-marks, and labels, so that foreign applicants who were surprised by the outbreak of the war may have a chance to have their rights protected which would otherwise be lost.

The CHAIRMAN. That is a war measure, then?

Commissioner EWING. Yes; purely.

Mr. CALLAWAY. An emergency act?

Commissioner EWING. Yes; an emergency act. For example, in an application for a patent the application must be signed and sworn to by the inventor, and it is impossible to reach him if he is in the field. If he has been killed his administrator or executor may execute it, and that takes time. It is to meet such emergencies that the bill is proposed.

As soon as the war broke out I took such steps as I could within the authority of the commissioner to relieve applicants, and the German patent office and the English patent office also took steps. I laid before the German ambassador what we had done, and as a result of the general liberality of our law and, I think, partly of the steps I had taken to relieve the situation, the German office published a statement that citizens of the United States were entitled to all the benefits of the relief granted by the German office. I state this because when the bill was proposed I thought it was necessary in order to secure to our citizens the benefit of the rights which the German patent office had extended and which they stated would be only granted where reciprocal rights were granted; but our country has been specially published in the German official publication, so that we do not have to pass this law in order to get that benefit.

The CHAIRMAN. As far as Germany is concerned?

Commissioner EWING. As far as Germany is concerned; and there is no other country that I know of in which any rights would depend upon the passage of this bill.

The CHAIRMAN. Then why pass it?

Commissioner EWING. I am stating this because, as I say, at the time I prepared the bill I thought it was necessary. Now it is not necessary. The question, therefore, is purely one of the wisdom of meeting an extraordinary situation by an amendment to the act which will give to foreign applicants in this country exactly the same advantage as the German office has given to us and to everybody else and which, I think, will be adopted generally throughout the countries of the world. So far as my information goes, nothing has been done particularly along this line except in Germany.

Now, my own feeling is that it is a wise and proper measure. If it were necessary to protect the rights of our citizens in Germany I should feel it was an extremely important measure to our citizens. But under the present circumstances and according to my present advices—because these things change from month to month—I can only present it as, in my judgment, a generally wise and proper measure.

The CHAIRMAN. May I ask you a question? In the first section I see you make it retroactive.

Commissioner EWING. Back to August 1.

The CHAIRMAN. The beginning of the war?

Commissioner EWING. Yes.

The CHAIRMAN. I suppose there will be no trouble about that from the constitutional standpoint?

Commissioner EWING. No; because no grant is made.

The CHAIRMAN. Section 3 says, "That section 1 of this act shall remain in force until the 1st day of January, 1917." Do you think it will be necessary to extend it that long?

Commissioner EWING. I think the war is likely to last all of 1916; and certainly the war conditions—that is, people getting back home and getting their business in shape, and all that. My fear is that we may have to ask a further extension, but I thought it was safe to put it at that.

Mr. Moss. Before you leave the first part of the bill, would you mind answering a question or two? Do you consider that the language of the bill is clear? The author of the bill does not say that a foreign applicant may have an additional nine months, but "an applicant for letters patent," etc. There are two or three questions that suggest themselves to me in connection with that: First, whether it could be construed to apply to a domestic patent.

Commissioner EWING. Yes; if he could show that it was on account of the existing state of war he could do it. For example, he might be caught over there himself.

Mr. Moss. In that connection how is it to be—that he is an applicant before he files his application?

Commissioner EWING. Well, his application is either accepted or rejected; that is, he does not get his patent unless he satisfies the condition.

Mr. Moss. Yes; but how is it to be ascertained that nine months before he would have filed his application?

Commissioner EWING. Oh, that would have to be done here. I think it is within the discretion of the commissioner to decide in each case whether it is a proper case for relief or not.

Mr. Moss. But speaking of the clearness of the language, it says: "Whenever an applicant is unable," etc. How are you to judge whether he was an applicant until he files his application?

Commissioner EWING. Well, whenever a man who becomes an applicant by filing his application sets up that he has been unable to file it under the existing act because of the state of war, I may give him an extension of nine months. That is what that means, I think.

Mr. Moss. That brings up this further question: What would you say, then, with reference to an American applicant filing his application for an identical patent with a foreigner who comes in eight months afterwards, where they both apply for exactly the same thing?

Commissioner EWING. The foreigner would have the benefit of the international convention under this act, just as he has now, with nine months in addition to the time that is allowed him now. Under the international convention, which has spread pretty much over the world, the foreign applicant who has an application abroad may file here within one year, and he gets the benefit of his foreign application date against a native applicant who comes in within a year and who can not carry his work back over the foreign filing date. This will give him 21 months.

Mr. MORRISON. Mr. Commissioner, may I ask you whether in every case the question of who was the first inventor is not an open question, to be determined in that case by such evidence as is admissible in that case?

Commissioner EWING. Yes; because the foreigner can only go back to his foreign filing date, whereas the American can go back indefinitely, so far as any work done in this country is concerned. The foreigner also can go back to any work that he did in this country, but as a practical matter the foreigner does his preliminary work abroad, and the American does his preliminary work here. So, while in theory we treat everybody exactly alike, in practice the work in this country is almost all done by citizens of this country, and it is the earliest date of work in this country that counts.

Mr. Moss. The effect of this bill would be to give the foreigner nine months advantage over the American, both claiming the same patent?

Commissioner EWING. Yes; it would.

Mr. MORRISON. Let me ask a question: Suppose the American is able to prove that he is the first inventor——

Commissioner EWING. Then the foreigner would not have the advantage. The point made by Mr. Moss is that under this act the foreigner may wait nine months longer than under the present act, but still go back to his original filing date abroad. That is the only advantage that it gives him. On the other hand, under the present law, if he does not file here within a year of the filing abroad, he can not go back to his original filing date, and furthermore if the foreign patent is issued first he loses that right.

The CHAIRMAN. The foreigner and the American citizen both have to convince the commissioner that the delay has been on account of the war?

Commissioner EWING. Yes.

The CHAIRMAN. They would stand on an equal footing there?

Commissioner EWING. They would stand on an equal footing there, except that I should probably have to accept an excuse from the foreigner which I would not accept from the American, because he would not be so likely to be affected.

The CHAIRMAN. He might be over there and could not come home.

Mr. Moss. Then, in the administration of this act, if the foreigner simply stated that he had intended to file his application before and could not do it on account of the war, would you permit that mere statement to entitle him to the benefit of the act?

Commissioner EWING. I think so, unless I had some reason to doubt it; that is to say, if he were within the war zone——

Mr. Moss. The effect would be——

Commissioner EWING. To extend it nine months.

Mr. Moss. If you administer it that way, the effect of it would be to give him nine months advantage over the American on what might be a totally false statement.

Commissioner EWING. Yes; that is true, but I think that statement would be open to attack. I think that if in administering the law I were to be very strict on a point of that sort it would defeat the favorable impression that the law is intended to give.

The CHAIRMAN. What effect has the war had on the filing of applications in your office?

Commissioner EWING. For a time it cut off applications from abroad almost entirely. We were receiving about 5,000 a year.

The CHAIRMAN. When the war started?

Commissioner EWING. When the war started. Latterly the foreign applications are beginning to come in again. It has, however, cut off a considerable number of foreign applications. I should say probably it has cut the 5,000 down to perhaps 2,000. As to the general business, we will have as many applications filed altogether this year as last, and when the Americans get in full swing we will have more applications than ever. That is my impression.

Mr. MOSS. Mr. Commissioner, just one more question. Don't you think it would be better for this bill to say that whenever the applicant convinces the commissioner by competent evidence under oath that he would have filed such an application, then this applies?

Commissioner EWING. Well, I think that is merely a question of policy. I see no serious objection to either procedure, but I am not inclined to be as strict as you would indicate, because in the end we are merely giving to a man who was the first inventor the benefit of his date. We are assuming a case now as between an American and a foreigner. If the American can go back of the foreigner's date he would beat him anyhow. If he can not go back of the foreigner's date, this act merely gives to the real first inventor the benefit of the date.

Mr. MORRISON. Now, let me ask you a question of law. Suppose a foreigner wants to take out a patent here, and an American files application for the same thing, and shows an invention at a date later than the date of the issuance of the patent, or the filing of the German application. Would the American then be entitled to a patent?

Commissioner EWING. He would have to show an invention prior to the grant of the foreign patent, not prior to the date of filing.

Now, when this situation broke on the world there were a large number of men who had applications from abroad in their hands to prepare, to send back to Europe for execution. They were then going to file them here. I accepted in such cases the applications signed by attorneys and sworn to by attorneys, and I published in the Scientific American a letter which I wrote to Munn & Co., setting forth why I did it. I should like to leave a copy of this and have the letter copied in the record.

(The letter referred to is as follows:)

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., September 15, 1914.

Messrs. MUNN & Co.,
Washington, D. C.

GENTLEMEN: I am accepting two applications filed by you as attorneys to-day wherein the inventor's name to the petition and specification is signed by you as attorneys, and the oath is made by a member of your firm. The time for filing these applications expires under the convention to-morrow. Therefore in filing these applications in the form in which you have presented them you are doing all that you can to save your client's rights, and in permitting them to be filed and giving them a serial number and date of filing of to-day I am doing all I can with the same end in view. If this should not prove to be effective, the loss must be attributed to the troubled conditions of Europe and not laid at your door or that of the office.

It will be necessary before patents are granted that applications be filed executed by the inventor himself, as provided in section 4888. Whether the applications to be filed can be tied to the applications which you are filing to-day under the provision of section 4887 is, of course, a matter which only a court of last resort can determine. Ex parte Tropenas (90 O. G., 749) to the con-

trary notwithstanding, I think it is a possible construction of section 4887 that its requirements may be satisfied by the filing of applications executed by an attorney.

I hope, however, in case there are a number of applications executed by attorneys that Congress may be induced to validate patents granted or to be granted upon proceedings indicated above.

Respectfully,

THOMAS EWING, *Commisioner.*

Commissioner EWING. The theory of it was this: I thought that if the attorney filed the application and it was within the date set by section 4887, and thereupon he forwarded the papers abroad and in the course of time got the signature of the inventor himself, and then filed a corrected application, Congress might be induced to validate those particular patents. I have kept a list of them, which I have here. No patents have been granted and no patents will be granted unless Congress authorizes it; but those people were doing the best they could, and, the emergency being very great, I adopted that course.

I also did it for one other reason, which I set forth in my letter, that I am not entirely clear that section 4887 would demand an application by the inventor himself, although section 4888 does, so that it might be possible for that to be sustained where it was filed within the year of the foreign patent under section 4887, but executed by an attorney, and then at a subsequent date before the granting of the patent executed by the inventor and a patent granted on the inventor's application. I said in this letter which was published in the Scientific American that everybody was merely taking his chance, that we were doing the best we could, and I would ask Congress to validate the patents, and if they chose to do so it would be feasible to get patents in that way. I did it mainly to show a disposition to help out, and it was that, among other things, that led to the German office publishing our country.

The CHAIRMAN. Does this bill do that?

Commissioner EWING. They can now come in under that bill and put in their applications.

Mr. Moss. Mr. Commissioner, there is one clause here that certainly does look to me defective, and that is section 3:

That section 1 of this act shall remain in force until the first day of January, nineteen hundred and seventeen.

Section 2 of the act says:

That all letters patent and registrations to which the preceding section applies shall have the same force and effect as if the applications and fees had been filed in accordance with the existing laws.

Now, what is the object in saying in section 3 that only section 1 is kept alive until 1917 and not keeping alive section 2, which, it seems to me, is a very material thing?

Commissioner EWING. Because in section 1 alone is any question of time involved. Section 3 says that this nine months' extension shall be continued under section 1 until the 1st day of January, 1917. Section 2 merely states in a general way what the effect of the other section shall be. I do not see any special reason in section 2 for saying how long it shall remain in force. In fact, it would remain in force for the whole life of the patent.

Mr. Moss. It ought to remain in force as long as the other.

Commissioner EWING. It ought to remain in force for the whole life of the patent. It does not expire on the 1st of January, 1917, because as long as there is a patent in existence granted under this act section 2 must remain in force. Otherwise the patent would be invalid after 1917.

Mr. Moss. Is it not usual, though, to say that "this act shall remain in force," without picking out a part of the act? It seems to me you want the patent to be validated and remain validated during the whole period. If you did not bring up the question of time I think your answer would be thoroughly satisfactory, but the question of time is brought up by section 3, and then you pick out a certain time for section 1 to operate, and we do not know what becomes of section 2.

Commissioner EWING. I had not thought of the point until just now, and I started to answer it without, perhaps, fully catching it, but I think I am right in my statement that section 2 must remain in force as long as there is a patent in existence granted under the act.

Mr. KREIDER. Why not simplify it by having section 3 read, "This act shall remain in force," etc., instead of saying "Section 1 of this act"?

Commissioner EWING. If section 2 does not remain in force longer than the 1st of January, what becomes of the patents after that period?

Mr. KREIDER. Well, section 2 is, as it were, auxiliary.

Mr. MORRISON. My suggestion now is to change the form of section 3 to read, "This act shall apply only to applications filed prior to January 1, 1917."

Commissioner EWING. That would be all right.

The CHAIRMAN. I do not see how section 2 would hurt anything, but I do not see for the moment how it strengthens it.

Commissioner EWING. Oh, I see what it is. Section 1 gives us the right to accept a fee and an application within the nine months' extension. Section 1, however, does not say that the patent shall date back to the date of the foreign application under section 4887; but section 2 says that it shall have the same force and effect as if the applications and fees had been filed in accordance with the existing laws, which does carry it, under section 4887, back to the date of the foreign application. That was the reason for that. We did not want to have to elaborate section 1 by any reference to section 4887, which would have been a difficult thing to draw, and therefore we put in that section saying that it shall have the same force and effect.

The CHAIRMAN. All foreign patents then date from——

Commissioner EWING. They date from the date of the application. That is the international convention, and this is intended to give the same benefit for nine months.

Mr. CALLAWAY. It would do that, Mr. Commissioner, under existing law, unless you changed that.

Commissioner EWING. The trouble is that the existing law says, "If the application is filed within one year."

Mr. CALLAWAY. So you simply changed the time of filing?

Commissioner EWING. That is true; but the phraseology is that the commissioner may accept an application or fee within an additional

nine months. It does not say what the effect of accepting it is, except, of course, the patent would be valid.

Mr. CALLAWAY. It would not have any effect at all under existing law?

Commissioner EWING. The patent would be valid, unquestionably, under section 1, but whether the patent would go back under the international convention——

Mr. CALLAWAY. There is not any question at all about it going back, unless your existing law is changed.

Commissioner EWING. It is not an existing law; it is an existing treaty or series of treaties. That was the reason for it. We thought it was better to have a general expression. Then by changing the form of section 3 as suggested by Mr. Morrison we get around any discriminations such as Mr. Moss spoke of.

The CHAIRMAN. What was that suggestion?

Commissioner EWING. That section 3 read, "That this act shall apply only to applications filed prior to the first day of January, nineteen hundred and seventeen."

Mr. Moss. I think that is satisfactory.

Commissioner EWING. Now, there is one other thing I want to say about this. If this act is going to be passed at all, if it can be passed at once it will give considerable time to cover those applications that ought to have been filed between the 1st of August and the present time; that is, they will have four months left. But if it drags along until the 4th of March there will only be two months left, and that is not time enough to communicate with them. So if the act is going to be passed, I think it ought to be passed promptly.

The CHAIRMAN. I do not think we shall have any trouble in the House if the committee decides in favor.

Commissioner EWING. I have here a list of applications in this country filed more than 12 months after the foreign date, up to this time. There are 205, approximately, applications signed by the inventors and filed after the year was up. Then I also have about 60 that have been signed by attorneys. I will produce those lists any time the committee wants them.

Now, what I want to say about this, in a general way—the reason for it, the value of it, and the importance of it—is this: We are constantly trying to extend our trade, of course; and at the present time it looks as if there were a big opening for the United States in foreign trade. Now, the privileges we get abroad are a matter of negotiation, and there is a great body of treaties affecting patents, trade-marks, and copyrights. I presume that trade-marks, altogether, are the most important part; patents next; and copyrights last. They are matters of grave and very far-reaching importance. I think we ought to do whatever we can reasonably to show that we are going to be just as liberal in meeting the difficulties of this situation as anybody else in the world, because that is always a good argument for more liberal treatment of us in these treaties. It is not a situation in which any trading can be done at all, because we can not do any business; we can not communicate. We simply do the thing as we think it ought to be done, with the hope that in the end we will get some advantage out of it. That is my feeling, although, as I said, when I

started the bill I thought it was necessary to protect our own citizens' rights.

Mr. CALLAWAY. If it was necessary to protect our own citizens, and they granted us that without the bill being passed, certainly we ought not to stop now.

Commissioner EWING. It would be the decent thing to do. I do not want the committee to rest under any mistaken impression about it because I stated I did not think it was necessary.

Mr. Moss. Mr. Chairman, it may be defeated, but I want to offer an amendment to this bill, because I do not think I can vote for it as it is. I wish to move that the word "is," in the fourth line, be stricken out, and that after the word "label," in the fourth line, the following words be inserted: "By evidence under oath shall convince the Commissioner of Patents that the applicant was."

My reasons are these: I think one of the great defects in the patent system and in the patent laws is the amount of delay that arises under them. I do not think we ought to add to that delay without some substantial foundation for it. Owing to the uncertainty of human life and the uncertainty of political appointment, we may not always have in this position our present efficient commissioner, and I do not believe that a mere statement by a foreigner that he would have filed his application if it had not been for the war ought to be sufficient. I can not see how he would be prejudiced by being required to give evidence under oath of it. It still leaves it within the discretion of the commissioner to decide whether that evidence is sufficient or not. Those are my reasons for offering that amendment. I should like to have it voted on.

Commissioner EWING. Under section 4894 applications must be acted upon within one year or otherwise are abandoned, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable. Now, we have a body of decisions interpreting that and applying it. If you were to adopt the same language there, it would be easier to construe and apply the act, and I think that meets your objection.

Mr. Moss. But in your testimony a while ago you said that the mere statement of the foreigner would be sufficient.

Commissioner EWING. But if you take this language in you will be stiffening the act up; and this particular language has been construed so that under the practice of the office they always require an oath. I should not object to that.

Mr. Moss. I think the commissioner's suggestion is all right, and I withdraw my other amendment and move that the word "is," in the fourth line, page 1, be stricken out and there be inserted after the word "label" the words: "shows to the satisfaction of the Commissioner of Patents that he has been."

(The motion was agreed to.)

The CHAIRMAN. Let us take up section 3 and decide upon that amendment.

Mr. MORRISON. My suggestion was in substance this: That this act shall apply only to applications that shall be filed prior to January 1, 1917.

The CHAIRMAN. "That this act shall not apply to any application filed after the 1st day of January, 1917."

Mr. MORRISON. I move the adoption of that as an amendment—as a substitute—for section 3.

(The motion was agreed to.)

Mr. MORRISON. I move the chairman be instructed to reintroduce this bill in the amended form just agreed to, to report it favorably, and to take such action as he may deem necessary to bring it before the House for action.

(The motion was agreed to.)

(Thereupon, at 12.05 o'clock p. m., the committee adjourned, to meet at the call of the chairman.)

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